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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,692	03/28/2001	Hirokazu Tanaka	ISH-001-USA-CIP	9945

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TOWNSEND & BANTA
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Washington, DC 20005

EXAMINER

WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 07/16/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/818,692

Applicant(s)

TANAKA ET AL.

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the certificate with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claims 1-17 and 23 are pending.

Applicant's arguments and declaration filed 4/19/03, with respect to claims 1-17 and 23, have been considered but are moot in view of the new ground(s) of rejection.

Priority

A careful comparison of the foreign priority document and the domestic priority documents, with the instant Application, results in an effective and actual filing date for the instant Application of 3/23/01. The description of SiO₂ as non-porous in the instant Application was not recited in either the foreign priority document or the domestic priority documents.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-17 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seo et al. (6,030,627) in view of Golz-Berner et al. (6,309,627).

The instant invention is directed toward methods of producing a flaky fine powder and compositions comprising these powders.

Seo et al. teach antimicrobial cosmetic pigments produced by forming an amorphous glass inorganic coating layer of metal oxides over the surface of inorganic cosmetic pigments and intercalating antimicrobial metals inside the lattice structure of the coating layer, and cosmetic compositions comprising these pigments. Silica, talc, and mica having a diameter of

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0.1-50um are taught as inorganic cosmetic pigments. It is respectfully pointed out that the thickness of a spherical particle is the particle's diameter. SiO₂ or a mixture of SiO₂ with ZnO, MgO, CaO, Al₂O₃, Li₂O, Na₂O, K₂O and/or Fe₂O₃, are taught as the coating layer. SiO₂ is taught as spherical. Neutralization-titration and sol-gel methods are taught for making the powders. Neutralization-titration involves dissolving sodium silicate in purified water, then dispersing the inorganic pigment with it, titrating with acid solution, precipitating, filtering, washing and drying. The sol-gel method involves adding a silane alkoxide to a water phase with an alcohol, whereto the inorganic pigment is dispersed. The solution is then gelatinized. Tetraethoxysilane is taught as a preferred silane alkoxide. The reference lacks a teaching of the average particle size of SiO₂ and SiO₂ being non-porous. See Col. 4, line 54-Col. 7, line 2; Col. 8, line 30-line 44; Col. 9, lines 1-28; Col. 10, lines 9-25; Col. 10, lines 37-56; Col. 11, lines 1-32; Col. 16, line 40-Col. 18, line 58.

Golz-Berner et al. teach cosmetic compositions containing agglomerates with particular particle sizes. The compositions comprise spherical non-porous SiO₂ particles with a particle size of 0.05-1.5um and other inorganic particle shaped materials with spherical structure. It is taught that the addition of non-porous SiO₂ particles of particular particle size to other essentially spherical particles does not cause any deagglomeration, but results in defined agglomerates whose particle size is particularly advantageous for cosmetic preparations to impart homogeneous spreading on the skin and very good reflection of UV radiation. See Col. 1, lines 40-51.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the SiO₂ of Seo et al. as having a diameter of 0.05-1.5 um and as being

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nonporous, as taught by Golz-Berner et al., because of the expectation of achieving a cosmetic composition that does not deagglomerate and that imparts homogenous spreading to the skin and that provides good reflection of UV radiation.

Furthermore, regarding the size of SiO₂, it is respectfully pointed out that it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

While the combination of references does not teach the permittivity of the dispersion, it is respectfully pointed out that since the combination of references teach the instant dispersion, the dispersion of the combined references must have the same properties. A compound and its properties are inseparable. In re Papesch, 315 F.2d 381, 137 USPQ 43 (CCPA 1963).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.


RUSSELL TRAVERS
PRIMARY EXAMINER